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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/814,705	03/23/2001	Junichi Minato	205059US2	4379
22850	7590	05/20/2005	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			GRANT II, JEROME	
			ART UNIT	PAPER NUMBER
			2626	

DATE MAILED: 05/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/814,705	Applicant(s) MINATO, JUNICHI	
	Examiner Jerome Grant II	Art Unit 2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 November 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 5-10, 13-18 and 22-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 11, 12 and 19-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

JEROME GRANT II
PRIMARY EXAMINER

Attachment(s)

- | | |
|---|--|
| <p>1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/03 and 8/04</u>.</p> | <p>4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____</p> <p>5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</p> <p>6) <input checked="" type="checkbox"/> Other: <u>Detailed Action</u></p> |
|---|--|

Detailed Action

1. Informality

Claim 21 did not have a period at the end of the claim. There appears to be only one limitation. The examiner has rejected that limitation.

2. Claims 1-4, 11, 12 and 19-21 have been elected for examination.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 11, 12 and 19-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Ohta (2001/0030760).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

With respect to claim 1, Ohta teaches an image processing device (gateway apparatus 20a and 20b) which transmits an image file to one or a plurality of external stations (10, 10b) through network (30, 40), comprising: a destination registering unit 21c storing a destination identifier (registered fax number of the destination) of the image file, the destination identifier indicating one of the external stations (fax numbers of the destination) to which the image file is transmitted from the image processing device; a sender registering unit 21c storing a identifier 10a of the image file (data packets as discussed at the middle of para. 22) indicating a person or group who sends the image file to said one of the external stations (see last 3 lines of para. 29), see also para. 29 lines 6-8. Ohta teaches transmitting unit 21(see figure 2) transmitting the image file, together with the stored sender identifier (inherent in that sender ID is sent in phase B portion of the fax protocol and the image is sent in phase C.

With respect to claim 2, Ohta teaches an imaging device (gateway apparatus 20a, 20b) which transmits an image file to one of a plurality of external stations through a network 30,40 comprising: a destination identifier (registered fax number of the destination) of the image file, the destination identifier indicating one of the external stations (fax numbers of the destination) to which the image file is transmitted from the image processing device; an image subject registering unit 21c storing a subject identifier of the image file, the subject identifier indicating one of a plurality of image subject indications (para. 29, lines 6-8) to indicate names of images in the image file being transmitted (number of fax machines as destination means) and transmitting unit 21(see figure 2) transmitting the image file, together with the stored sender identifier (inherent in that sender ID is sent in phase B portion of the fax protocol and the image is sent in phase C.

With respect to claim 11, Ohta teaches an image processing device 20a, 20b which transmits an image file to one of a plurality of external stations 10a, 10b) through network 30, 40, comprising: an image memory 21c storing a plurality of image data read from documents scanned by scanner unit that is inherently in a fax machine; and transmitting unit 21(see figure 2) transmitting the image file, together with the stored sender identifier (inherent in that sender ID is sent in phase B portion of the fax protocol and the image is sent in phase C; an image data selecting unit (packer

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converter 25) selection one of a plurality of document identifiers (para. 27, lines 9-14), see also para. 21, lines 5-11 of an image file (document list) which is transmitted to one of the external stations 10a, 10b through network 30, 40 (see also paras 23 and 25) in accordance with key-in information that is input by an operator; and destination identifier (packet analyzer 26 in combination with information for generator 24 for selecting a fax machine as a destination machine based upon identification data sent from devices 30, 40), selecting identifiers in accordance with information keyed in by an operator/user of a computer, according to para. 33.

With respect to claim 12, Ohta teaches a plurality of files stored in 21c derived from scanning units, which are inherent by fax machines 10a and 10b) into a single image file before the file transmission, so that the transmission unit transmits the combined image file to the external station via packet converter 25.

With respect to claim 19, Ohta teaches, an image processing device (gateway apparatus 20a and 20b) which transmits an image file to one or a plurality of external stations (10, 10b) through network (30, 40), comprising: a destination registering unit 21c storing a destination identifier (registered fax number of the destination) of the image file, the destination identifier indicating one of the external stations (fax numbers of the destination) to which the image file is transmitted from the image processing device; a personal information registering unit 21c storing a plurality of personnel information items (registration of fax numbers) related to a number of personnel of a

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sender group, the personnel information items being correlated to respective personnel identifiers (i.e. recipient A has fax number 1234567,; and a transmission unit 21 transmitting the image file (generated from scanners of fax machines 10a or 10b) with relevant personnel information item; transmitting the image file, together with the stored sender identifier (inherent in that sender ID is sent in phase B portion of the fax protocol and the image is sent in phase C.

With respect to claim 20, Ohta teaches the claimed subject matter as discussed at para. 30 regarding the plurality of identifiers pertaining to plural fax machine numbers. The protocol generator 21 is responsible for the processing.

With respect to claim 21, Ohta teaches the destination registering unit 21c.

3.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ohta in view of Kanaya.

With respect to claim 3, Ohta teaches , Ohta teaches an image processing device (gateway apparatus 20a and 20b) which transmits an image file to one or a plurality of external stations (10, 10b) through network (30, 40), comprising:

a destination registering unit 21c storing a destination identifier (registered fax number of the destination) of the image file, the destination identifier indicating one of the external stations (fax numbers of the destination) to which the image file is transmitted from the image processing device and and transmitting unit 21(see figure 2) transmitting the image file, together with the stored sender identifier (inherent in that sender ID is sent in phase B portion of the fax protocol and the image is sent in phase C.

What Ohta does not teach is the scan condition registering unit as claimed.

Kanaya teaches a scan condition registering unit which indicates a resolution of the scan criteria and transmits it along with the image file. See col. 5, lines 63-67.

Since Ohta and Kanaya are both directed to the art of image processing and scanning image documents, the use of registering a scan condition would have been contemplated by Ohta as set forth by Kanaya.

It would have been obvious to one of ordinary skill in the art to obtain or modify the scanning means so that a scanning resolution by means of the scanners in the fax machines 10a and 10b of Ohta is obtained and registered so that resolution data is transmitted along with the image information, set forth by Kanaya, for the purpose of determining a resolution of an image file while it is being processed and transmitted over by means of a processing device over a network.

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4.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 4 is rejected under 35 U.S.C. 102(e) as being anticipated by Fujise.

2002/0057773

Fujise teaches an image processing method for transmitting an image file from an image processing device to one of a plurality of external stations through a network, comprising the steps of:

Storing a destination identifier (destination abbreviation) of the image file (in DRAM 114), the destination identifier indicating one of the external stations (one of plural fax terminals connected to 111) to which the image file is transmitted from the image processing device; storing at least of a sender identifier of the image file, (also in DRAM 114) a subject identifier (specific page number of the image file in the header, see paragraph 155 and 156) and a scan condition (specified in para. 153) of the image file; and transmitting the image file, together with said at least one of the sender identifier, the subject identifier and the scan condition, (identifier data and the resolution data are included in the header) through network to said one of the external stations indicated by the stored destination identifier. See para. 160 last five lines.

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5.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerome Grant II whose telephone number is 571-272-7463. The examiner can normally be reached on Mon.-Thurs. from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A. Williams, can be reached on 571-272-7471. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

✓
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